

### **REMARKS**

Within the presently amended application, claims 1-11, 13-14, 31-33, 35-36 and 38-39 are currently pending. Claims 12 and 34 have been canceled without prejudice in response to the PTO's objection under 35 CFR 1.175 as being substantially duplicate of claim 31. Additionally, claim 37 has also been canceled without prejudice.

#### **Claim Rejections under 35 U.S.C. § 103**

Claims 31, 34-36, 38 and 39 have been objected to by the PTO as being unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,739,194 to *Natesh* in view of U.S. Patent No. 5,360,835 to *Sato et al.* The PTO states that *Natesh* teaches a water-based coating composition comprising a urethane prepolymer, a urethane acrylate and a ferric ion graft initiator. The PTO states that *Natesh* does not specifically teach or disclose a coating composition containing a latex, however, the PTO states that *Sato et al.* teaches a coating comprising a latex. Additionally, the PTO has objected to claims 1-14 and 31-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,414,048 to *Sanduja et al.* in view of *Sato et al.* as evidenced by U.S. Patent No. 6,245,267 to *Kreiser et al.* As previously noted by the PTO, neither *Sanduja et al.* or *Kreiser et al.* teaches a coating containing a latex, however, the PTO states that *Sato et al.* teaches a latex. The PTO states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the rubber latex taught in *Sato et al.* in a coating motivated by the desire to facilitate the mixing and processing of materials and further to provide the coating with a higher tear strength.

Furthermore, claims 1-3, 6, 8, 9, 12, 14, 31-34 and 36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,214,460 to *Bluem et al.* in view of U.S.

Patent No. 6,565,969 to *Lamon et al.* The PTO states that *Bluem et al.* teaches a water-based adhesive composition comprising the claim components bonded by a polyethylene foam. The PTO further states that the foam in *Bluem et al.* would inherently have the claim density as the present application since it is identical in chemical composition. Additionally, the PTO states that while *Bluem et al.* does not teach a composition comprising a latex, *Lamon et al.* does. The PTO states that the motivation for combining these two references would be that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the rubber latex and the adhesive coating motivated by the desire to facilitate the mixing and processing of the materials and to further provide the coating with a higher tear strength.

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1584, 3 U.S.P.Q.2d 1436, 1439 (Fed. Cir. 1987). Initially, the PTO bears the burden of establishing the *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed Cir. 1984). To establish a *prima facie* case, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgem, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). To support a conclusion of obviousness, "either the

references must expressly or impliedly suggest the claimed combination or the [PTO] must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). In evaluating obviousness, the Federal Circuit made it very clear that one must look to see if "the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success viewed in light of the prior art." *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

Within the Official Action, the PTO has admitted that the combined art does not teach that which is claimed in the present application. Furthermore, the PTO asserts that one of ordinary skill in the art would be motivated to use a reference which teaches a latex with the references lacking the teaching of the addition of a latex. The PTO states that one would be motivated to combine the references teaching a latex such as *Lamon et al.* and *Sato et al.* because one of ordinary skill in the art at the time the invention was made would use rubber latex in the adhesive coating motivated by the desire to facilitate the mixing and processing of materials and to further provide a coating with a higher tear strength. Applicants respectfully assert that the PTO has not shown from the cited art the requisite motivating factors of facilitating mixing and processing the materials and to provide a coating with a higher tear strength. The motivating factors of mixing and processing with higher tear strength must be found within the cited references. The PTO can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of

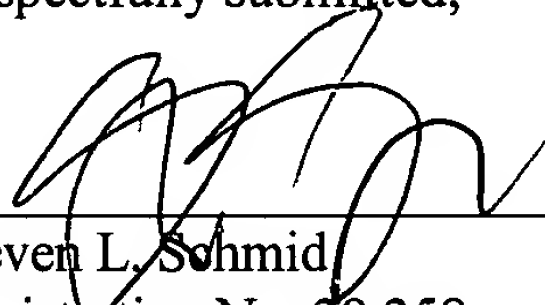
ordinary skill in the art would lead that individual to combine the relevant teaching of the references. *In Re Lee*, 61 USPQ 2d 1430 (CAFC 2002). Furthermore, the factual question of motivation is material to patentability, and cannot be resolved on subjective belief or unknown authority. *Id.* At 1434.

Upon entry of the above amendment, claims 1-11, 13-14, 31-33, 35-36, 38 and 39 remain pending in the present application. Applicants urge that the present application is now in a condition for an allowance and an early notice of such is earnestly solicited. However, if it is believed that any issues remain unresolved in the present application, Applicants request that the Examiner contact the undersigned.

Date

1/15/04

Respectfully submitted,

  
Steven L. Schmid  
Registration No. 39,358

Womble Carlyle Sandridge & Rice, PLLC  
P.O. Box 7037  
Atlanta, GA 30357-0037  
(404) 962-7539 (Telephone)  
(404) 870-8234 (Facsimile)